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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,084	11/13/2003	Nicholas James Witchev	021404.0012US1	7909
34284	7590	12/11/2008		
Rutan & Tucker, LLP. 611 ANTON BLVD SUITE 1400 COSTA MESA, CA 92626			EXAMINER DINH, KHANH Q	
			ART UNIT 2451	PAPER NUMBER
			MAIL DATE 12/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,084	Applicant(s) WITCHEY, NICHOLAS JAMES	
	Examiner Khanh Q. Dinh	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the Election/Restriction Remarks filed on 11/6/2008.

Applicant elect group I (claims 1-11) without traverse for examination. Therefore, claims 1-11 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hovel et al., US Pat. No.7,116,681.

As to claim 1, Hovel discloses a communication protocol converter comprising:

(a) a first modular communication jack having: i) a housing defining an open cavity and a segregated interior chamber; ii) a connector port having a plurality of electrical contacts positioned within said open cavity; iii) at least one circuit board incorporating Ethernet to raw data conversion circuitry components for a first communication protocol disposed within said interior chamber in electrical communication with the electrical

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contacts of said connector port; and iv) a memory positioned on said circuit board in electrical communication with said conversion circuitry for a first communication protocol for receiving converted data (using network controller to process data conversion, see figs.1, 2, col.6 line 13 to col.7 line 50); (b) a second modular communication jack having: i) a housing defining an open cavity and a segregated interior chamber; ii) a connector port having a plurality of electrical contacts positioned within said open cavity; iii) at least one circuit board incorporating Ethernet to raw data conversion circuitry components for a second communication protocol disposed within said interior chamber in electrical communication with the electrical contacts of said connector port; iv) a memory positioned on said circuit board in electrical communication with said conversion circuitry for said second communication protocol for receiving converted data (see fig.2, col.7 line 17 to col.8 line 58); and (c) a bidirectional data interface electrically interconnecting said memory of said first communication jack with said memory of said second communication jack (see col.8 lines 10-58).

As to claim 2, Hovel discloses said first communication protocol is Internet protocol version 4 and said second communication protocol is Internet protocol version 6 (see col.8 lines 10-58).

As to claim 3, Hovel discloses said first communication protocol is Internet protocol version 6 and said second communication protocol is Internet protocol version 4 (see

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fig.1, col.8 lines 10-58).

As to claim 4, Hovel discloses said conversion circuitry components of said first and second modular communications jacks includes magnetic circuitry and controller circuitry (see col.9 line 20 to col.10 line 50).

As to claim 5, Hovel discloses said conversion circuitry components includes LED circuitry (see col.9 line 20 to col.10 line 50).

As to claim 6, Hovel discloses said circuit boards each define first and second opposed sides and said conversion circuitry components are positioned on both first and second sides of said circuit boards (see col.7 line 8 to col.8 line 59 col.9 line 20 to col.10 line 50).

As to claim 7, Hovel discloses a communication protocol converter comprising:
a housing defining first and second open cavities and a segregated interior chamber;
each of said open cavities incorporating a plurality of electrical contacts positioned within said open cavities to form first and second connector ports wherein said first connector port is adapted to interface with a first communication protocol and said second connector port is adapted to interface with a second communication protocol (using network controller to process data conversion, see figs.1, 2, col.6 line 13 to col.7 line 50); and at least one circuit board incorporating communication protocol conversion

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circuitry components disposed within said interior chamber in electrical communication with the electrical contacts of said first and second connector ports wherein said conversion circuitry bidirectionally translates communication protocols (network protocol translation, see fig.2, col.7 line 17 to col.8 line 58).

As to claim 8, Hovel discloses said protocol conversion circuitry comprises, a microprocessor incorporating embedded software for converting a first communication protocol received at said first connector port to a second communication protocol output to said second connector port (processing protocol translations, see fig.2, col.8 lines 10-58).

As to claim 9, Hovel discloses said microprocessor converts a second communication received at said second connector port to a first communication protocol output to said first connector port (see col.7 line 8 to col.8 line 59 col.9 line 20 to col.10 line 50).

As to claim 10, Hovel discloses said first communication protocol is Internet protocol version 4 and said second communication protocol is Internet protocol version 6 (see fig.1, col.8 lines 10-58).

As to claim 11, Hovel discloses said first communication protocol is Internet protocol version 6 and said second communication protocol is Internet protocol version 4 (see

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fig.1, col.8 lines 10-58).

Other prior art cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Nakamura, US pat. No.5,842,045
- b. Tsuchiya et al, US pat. No.7,116,681.
- c. Collins, US pat. No.5,671,355.

Conclusion

5. Claims 1-11 are rejected.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FOLLANSBEE JOHN, can be reached on (571) 272-3964. The fax phone number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for patents

P O Box 1450

Alexandria, VA 22313-1450

/Khanh Dinh/

Primary Examiner, Art Unit 2451